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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,160	03/20/2004	Joseph A. Deming	JAD01/DIV	8633

7590

07/27/2005

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12 GOOD HILL RD
BETHEL, CT 06801

EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary**Application No.**

10/805,160

Applicant(s)

DEMING, JOSEPH A.

Examiner

Eric B. Compton

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-26, 28, 29 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26, 28, 29 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a divisional of Application No. 10/086,798, filed March 4, 2002." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

Specification

2. The disclosure is objected to because of the following informalities: On page 2, line 6 the reference U.S. Pat. 4,578,981 appears to conflict with the reference cited on page 1, of U.S. Pat. 4,575,981. The former reference is not directed towards the invention described by Applicant.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 is dependent on canceled claim 22.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23, 26, 28-29 and -31 are rejected under 35 U.S.C. 102(e) as being anticipated by PCT/GB01/04941, which published as WO 2003/046306 to Ponting et al. See Derwent Abstract.

Regarding claim 23, Ponting discloses a method of making a structural roof panel (see Figures 1-3), said method comprising (see page 2):

providing an upper membrane (3, first metal steel);

providing a lower membrane (1, second metal sheet);

providing an intermediate layer between said upper and lower membranes (2, volume of insulating material); and

adhering to said upper membrane an outer membrane of polyisobutylene (7, see page 3, line2); wherein

said upper and lower membranes are provided on rolls (see page 2, steps A + B) which are controllably unrolled generally simultaneously, while said upper and lower membranes are maintained in spaced apart, generally parallel relationship;

said outer membrane is provided on a roll which is positioned above said upper membrane and controllably unrolled (see page 2, step A);

an adhesive (see page 4, last paragraph) is applied between said upper membrane and said outer membrane; and a pressure roller biases said outer membrane against said upper membrane to facilitate adhesion therebetween (see page 2, step A).

Regarding claim 26, as shown in Figure 3, the sidewalls may include a tongue and groove configuration between adjacent panels.

Regarding claim 28-29, as shown in Figure 3, a plurality of roof panels may be used, which are a portion of each are overlapped.

Regarding claim 31, the adhesive may be pre-applied. See Page (bottom full paragraph).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponting in view of U.S. Pat. 3,061,502 to McDonald.

Ponting discloses the invention above. As shown in Figure 2, the outer membrane is cut to extend past or overhang the length of the panel. Clearly two cutters are needed: one to cut the panel and another to cut the outer membrane. However, the

reference does not disclose the exact steps claimed by Applicant in dependent claims 24-25.

McDonald discloses a method for forming a waterproof panel for roofs, having an overhang. See Figure 8. As shown in Figure 7, for example, a first panel cut to length by first cutter (46), a membrane (51) of waterproof material is then applied to the cut panel subsequent to applying adhesive (52) and the membrane is cut to form an overhang by second cutter (54). This allows for the production in a continuous manner of the panel having an overhang, which helps to seal when the panels are assembled. See Figures 9-10.

Regarding claims 24-25, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the overhang of Ponting, by providing two cutters in the claimed sequence, in light of the teachings of McDonald, in order to form an overhang in a continuous manner.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726

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